

REMARKS

Claims 1-6 were pending. Claim 5 has been canceled and claims 1-4 and 6 have been amended in response to the rejection under Section 112, second paragraph.

Applicant gratefully acknowledges the indication of allowable subject matter.

AMENDMENT OF SPECIFICATION

The specification has been amended to correct an obvious clerical error and does not raise an issue of new matter. A skilled organic chemist would have appreciated that the molar ratio of 2,6-dimethylbenzoic acid, potassium carbonate and methyl iodide in the reaction was approximately 1:1:2.

The specification amendment was originally presented in a Preliminary Amendment dated September 11, 2003. In view of the fact that the September 11, 2003 Amendment has not been acknowledged either by a postcard receipt or in the June 25, 2004 Office Action, applicant is presenting that amendment again.

FORMAL DRAWINGS

The Office Action stated, "The drawing(s) filed on 31 March 2004 is/are: objected to by the Examiner." (Office Action, page 1, box 10). Applicant submits herewith two sheets of formal drawings for Figures 1 and 2. The formal drawings submitted herewith do not raise an issue of new matter.

IDS ENTITLED TO CONSIDERATION

On May 28, 2004 applicant submitted a Supplemental Information Disclosure Statement (IDS) to make of record an International Search Report issued in connection with the PCT International Application corresponding to the subject application. The May 28, 2004 Supplemental IDS was filed before the mailing of a first Office Action on the merits in the subject application, and moreover contained the Statement specified in 37 CFR 1.97(e)(1). Accordingly the Supplemental IDS is entitled to consideration. Applicant respectfully requests an initialed copy of the Form PTO-1449 submitted therewith.

Claims 1-6 in the pending application correspond to claims 71-75 and 78 of the international application. Based on the identification in the Search Report of international application claims to which the documents cited therein were considered to be relevant, applicant believes the claims in the subject application to be patentable over such documents.

CLAIMS ARE NOT INDEFINITE

Claims 1-6 have been rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. This rejection is respectfully traversed.

The first ground of rejection was based on the recitation of "A biologically active agent" in the preamble to claims 1 and 4. Although applicant disagrees with the basis of the rejection, in order to advance prosecution the claims have been amended to recite a "compound" as recommended in the Office Action.

Support for the claims as amended may be found, *inter alia*, in the claims as originally filed. Applicant maintains that the amendment does not introduce new matter. The original preamble did not limit the claims. It neither recited essential structure or steps, nor was it necessary to give life, meaning and vitality to the claim, nor did applicant rely on the preamble to distinguish the claimed invention from the prior art. See Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc., 289 F.3d 801, 808, 62 USPQ.2d 1781, ____ (Fed. Cir. 2002).

The second ground of rejection was based on the recitation of values for R^4 , which variable does not appear in Formula II or IIa. Applicant notes a similar issue with the recitation of R^1 . Claims 1 and 4 have been amended to delete references to R^1 or R^4 . Claim 5, which defined values of R^1 , has been canceled. The dependency of claim 6, which previously depended on canceled claim 5, has been changed.

Applicant respectfully submits that the amendments overcome the rejections under Section 112, second paragraph.

CONCLUSION

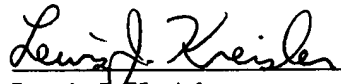
Reconsideration of all objections and rejections is respectfully requested. Applicant believes that the subject application is in condition for allowance and looks forward to a favorable action.

It is believed that no fee is required in connection with the filing of this Amendment. If

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any fee is required, the Commissioner is hereby authorized to charge the amount of such fee to Deposit Account No. 50-1677.

Respectfully submitted,

A handwritten signature in cursive script, reading "Lewis J. Kreisler", written over a horizontal line.

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Enclosure: Formal drawings (2 sheets)